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In re Application of
Kazuhiko Sugiyama et al
Application No. 10/506,671
Filed: September 4, 2004
Attorney Docket No.: 040478
For: PIPE JOINT

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: DECISION ON PETITION
: REGARDING INFORMATION
: DISCLOSURE STATEMENT
:
:

This is in response to applicants' petition filed October 9, 2008 seeking to have the International Search Report dated July 8, 2003 that was included in the Information Disclosure Statement of on December 29, 2004 considered by the examiner; applicants' petition filed October 10, 2008 seeking to have the European Search Report dated October 20, 2005 that was included in the Information Disclosure Statement filed on January 4, 2006 considered by the examiner; and applicants' second petition filed October 10, 2008 seeking to have the supplementary European Search Report dated January 23, 2006 that was included in the Information Disclosure Statement filed on February 21, 2006 considered by the examiner. These three petitions pertain to the same issue as directed to three different IDS submissions and thus will be treated together in this decision.

The petition is **GRANTED**.

Applicants indicate that the respective citation of the International Search Report dated July 8, 2003, the European Search Report dated October 20, 2005 and the supplementary European Search Report dated January 23, 2006 complied with all of the requirements as set for by 37 CFR 1.97 and 37 CFR 1.98 and thus the examiner had an obligation to consider these documents instead of lining them out as not considered.

A review of the record reveals that applicants are correct in that the IDS submissions with respect to these three citations complied with all of the requirements of 37 CFR 1.97 and 37 CFR 1.98.

In this regard, it is noted that applicants have a duty to disclose to the Office information which is material to patentability as defined by 37 CFR 1.56. The provisions of 37 CFR 1.97 and 37 CFR 1.98 provide a mechanism by which patent applicants may comply with this duty of

disclosure. These provisions define minimum requirements for the submission of information to the Office.


MPEP 609 states:

*"Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. There is no requirement that the information must be prior art references in order to be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the **PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above."*

Accordingly, it is evident that while applicants have a duty to disclose materially relevant information, there is no requirement that only materially relevant or prior art information be disclosed and included with any IDS submission.

Since applicants submission of the three documents in question met the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98, the examiner was obligated to consider such documents and indicate such consideration by initialing adjacent the citations. Thus, the examiner's lining through of these citations as "not considered" was in error. The application is being forwarded to the examiner so that these citations may be properly initialed as "considered".

Any questions regarding this decision should be directed to Supervisory Patent Examiner Daniel P. Stodola at (571) 272-7087.


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SNM/DS: 1/13/09

